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APPLICATION NO. 09/625,228	FILING DATE 07/24/00	FIRST NAMED INVENTOR CAPLAN	ATTORNEY DOCKET NO. D A-67467-2/RB
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EXAMINER TRAN, K	
ART UNIT 3634	PAPER NUMBER

DATE MAILED: 07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/625,228

Applicant(s)

Caplan et al.

Examiner

Khoa Tran

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 07-24-00 and the amendments of 10-23-00 and 01-30-01

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 15-21, 23, and 27-46 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 15-21, 23, and 27-46 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Jul 24, 2000 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Art Unit: 3634

## **DETAILED ACTION**

### ***Drawings***

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. The drawings are objected to because they fail to show the reference numerals "360", "410", "390", and "510" as described in the specification on page 17, line 6, page 18, lines 2 and 4, and on page 21, line 12. Appropriate correction is required.

Applicants are required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

### ***Specification***

The disclosure is objected to because of the following informalities: On page 7, line 28, "desire object 18" should be --container 18-- and line 32, "object 18" should be --container 18--. Relatively, on page 23, line 3, first and second occurrence "object 18" should be --container 18-- in order to maintain the same terminology associates with the reference numeral. On page 9, line 1, "34a" should be --35a--, on page 13, line 11, "34b" should be --34a-- and line 27, "35b" should be --34a-- in order to agree with what has been shown in the drawings. On page 18, line 4 and 12, the specification is objected to because the inconsistent terminologies associate with the

Application/Control Number: 09/625,228

Art Unit: 3634

Neither prelim amend has  
been entered

cl 30, 40  
cl 19 combs/pub  
cl 23 on cancel  
cl  
Page 3

reference numeral "410", and on line 29, "transducer 90" should be --transducer 490--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-21, 23, and 27-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 15, applicants should be noted that part of a product claim is based on the structural recitations of that product, it appears that the claim fails to structurally recite the product because the structure which goes to make up the device is not completely set forth such a manner as to present a complete operative device. Further, it is unclear to what applicants intend to set forth with recitations of "injection-modable", line 1, and "when desired", line 10. In particular, does the holder require only to have the potential of being formed by injection molding? and is forming a loop is being required or not? With respect to claim 20, it is unclear to what applicants intend to set forth with recitation of "side-by-side" configuration. In particular, "side-by-side" configuration would be read on the immediate adjacent holder that is located either below and above of the holder. Further, it is unclear whether the "compact disk jewel cases" is being referred to is the same element as "one object" in claim

Art Unit: 3634

15. It appears that claim 20 should be dependent from claim 19 in order to make sense. Claim 27, there is no antecedent basis for "a third", line 12. Claim 46 is a double recitation of claim 38.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17, 19, 20, 27, 28, 30, 34, 37, 40, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by the Deutsche Patent No. DE9313107. Deutsche Patent No. DE9313107 discloses an injection-moldable holder usable to create a continuous loop forming by matingly interlocks with the adjacent holders, the holder comprising a plurality of one unitary piece holders each having a first and second spaced-apart walls (10) configured to form a slot therebetween for retaining an object therein, see Figure 8a. Each holder has a first holder-engaging mechanism (21) that is disposed to matingly interlock with the second holder-engaging mechanism (23) and the second holder-engaging mechanism matingly interlocks with the third holder. See Figures 6 and 7b.

Claims 23, 27, 28, 37, and 41, are rejected under 35 U.S.C. 102(b) as being anticipated by H. C. Smith. Smith discloses a holder usable to create a continuous loop forming by matingly interlocks with the adjacent holders, the holder comprising a plurality of one unitary piece holders

Art Unit: 3634

(29), see Figure 6, each having a first and second spaced-apart walls configured to form a slot therebetween for retaining an object therein. Each holder has a first projected outward curved holder-engaging mechanism (27) that is disposed to matingly interlock with the second projected outward holder-engaging mechanism (28) and the second holder-engaging mechanism matingly interlocks with the third holder. See Figures 2 and 3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-21, 27-40, and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsche Patent No. DE9313107 in view of Callahan et al. Deutsche Patent No.

DE9313107 discloses an injection-moldable holder usable to create a continuous loop forming by matingly interlocks with the adjacent holders, the holder comprising a plurality of one unitary piece holders each having a first and second spaced-apart walls (10) configured to form a slot therebetween for retaining an object therein, see Figure 8a. Each holder has a first holder-engaging mechanism (21) that is disposed to matingly interlock with the second holder-engaging mechanism (23) and the second holder-engaging mechanism matingly interlocks with the third holder. See Figures 6 and 7b. Callahan et al. teach the flexible spring projections with an L-

Art Unit: 3634

shaped slot (19-1 and 19-2, see Figures 4A-B and 5A) formed on the first and second walls of the holder. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the side walls of holders of Patent No. DE9313107 with flexible spring projections as taught by Callahan et al. in order to have the springs to secure the object that is placed therein the holder. With respect to the holder that is formed from injection molded plastic, it should be noted that injection molding is notoriously old and well-known per se in the industry of making a holder and plastic is a well-known material. Accordingly, it would have been no more than an obvious matter of engineering design choice to select the type of well-known material of plastic to produce the holder by a well-known process of injection molding base on the desire application thus producing no new matter and unexpected results because it is well within the level of skill of one of ordinary skill to utilize known features of the art for the purpose that they are known. With respect to claims 29 and 39, it would have been an obvious matter of engineering design choice as determined through routine experimentation and optimization for one of ordinary skill in the art to routinely dimension the spaced-apart first and second walls to be approximately 5 inches for a particular application thus producing no new matters.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Ma and Mah are cited to show similar configurations of design.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 8:30 A.M. to 7:00 P.M.

Art Unit: 3634

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. \_\_\_\_\_ ) on \_\_\_\_\_  
(Date)



Art Unit: 3634

Type or printed name of person signing this certificate:


\_\_\_\_\_

\_\_\_\_\_  
(Signature)

Furthermore, please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Khoa Tran

June 15, 2001



Alvin Chin-Shue  
Primary Examiner